

AS

Notice of Allowability

Application No.

10/044,746

Examiner

Daniel Zirker

Applicant(s)

SHAH, KUMUD

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1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to ____.
2. ☒ The allowed claim(s) is/are 1-8.
3. ☐ The drawings filed on ____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
 - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date ____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date ____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____.

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121

I. Claims 1-10, drawn to a packaging tape, classified in Class 428, subclass 343.

II. Claims 11-15, drawn to a method of manufacturing a packaging tape, classified in Class 156, subclass 187.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as the divider can be applied to the flexible transparent material after winding onto an elongated core utilized for winding the flexible transparent material which defines an intermediate roll where the divider can be placed on the flexible transparent material after a desired number of windings.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as

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shown by their different classifications, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Joseph Sebolt and the prior Examiner of record on February 3, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

7. Authorization for this Examiner's Amendment was given in a telephone interview with Joseph Sebolt on February 25, 2004.

8. In the Claims:

In claim 1, lines 2 and 3, delete "and being adapted to be wound on a core";

in line 4, delete "around the core".

Cancel claims 9 and 10, as well as non-elected claims 11-15.

9. The following is an examiner's statement of reasons for

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allowance:

The Examiner has several observations concerning the allowability of the present application. Initially it is noted that after conferring with applicant's attorney, it was agreed that the presence of a core in claim 1 was not a necessary structural feature, and also that the claim language should clearly indicate that the flexible transparent member was in fact wound around some form of central aperture which may be, e.g. either a core material or just a central aperture which need not be specified in the claims, since this particular feature is not an essential element of the invention. Additionally, the Examiner believes that the phrase "being adapted to be wound on a core" would have made the claim read on non wound tape structures, which is no longer believed to be the case. With respect to claims 9 and 10, these read upon essentially any flexible non-transparent member, since the great majority of claim 9 is simply patently insignificant method of contemplated use language, and as such it was agreed to cancel these claims, as well as non-elected claims 11-15.

With respect to the cited prior art, none of the prior art discloses the essential concept of the invention, namely a flexible non-transparent divider that is positioned somewhere in between the innermost and outermost windings of a tape, whether

rolled on a core or simply rolled about a central aperture. With respect to the cited prior art, Kao et al., U.S. 6,224,705 does not disclose anything but an improved type core structure, i.e. even if the core element of this patent were a "divider", it would not be positioned in between the innermost and outermost windings as required by applicant's claim 1. Kao, U.S. 5,366,775, and Yucel, U.S. 3,648,835, both disclose either the presence of holes (Kao) or visually distinguishing markings (Yucel) that simply do not read upon, or make obvious the claimed divider located in its claimed position as set forth in applicant's claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. The drawings are objected to because the numbers and letters which identify various elements in the drawings are informally set forth, and in some places are blackened out and need to be properly drawn. Correction is required.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner

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can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

February 25, 2004